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| 10/658,844 | 09/08/2003 | John M. Morales | 026595-007510US | 5408 |
| 20350 7590 01/23/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834 | | | | |
| | | | EXAMINER GRAHAM, CLEMENT B | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/658,844

Applicant(s)

MORALES ET AL.

Examiner

Clement B. Graham

Art Unit

3696

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/22/08.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11-14, 16, 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11-14, 16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 10/23/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 6-19, 15, and 17 has been cancelled and claims 1-5, 11-14, 16, 18-22 remained pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 11-14, 16, 18-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence U.S Pub: 2004/ 0024693 in view of Lawrence et al (Hereinafter Lawrence1, U.S Pub: 2004/0006532).

As per claim 1, Lawrence discloses a method of producing a suspicious activity report, comprising:
storing configuration information at a transaction processing device (see column para 0027), wherein the configuration information configures the device to produce suspicious activity reports based on certain criteria, and wherein the certain criteria ("i.e. risk criteria" see column 6 para 0067-0072) comprises both a mandatory SAR threshold and a SAR prompt threshold (see para 0090) receiving transaction information (see column 2-3 para0027 and para 0076) determining, based on the transaction information and the certain criteria, whether a suspicious activity report is to be prepared, wherein determining whether a suspicious activity report is to be prepared (see column 8 para 0089 and column 9 para 0091) comprises:
and, generating a suspicious activity report containing at least some of the transaction information (see column 8 para 0089 and column 9 para 0091 column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044) and SAR prompt threshold

Art Unit: 3696

and, in accordance with the comparison, displaying a prompt that asks an operator if he wants to prepare a suspicious activity report(see column 8 para 0090 and 2 para 0019).

Lawrence fails to explicitly teach comparing an amount of a transaction to the mandatory SAR threshold in accordance with comparison.

However LawrenceI discloses Retrieving information related to risk variables from the aggregated data is an operation with the goal to fulfill a given a request. In order to process a request against a large document set of aggregated risk data with a response time acceptable to the user, it may be necessary to utilize an index based approach as opposed to a direct string comparison search which may be unsuitable (see column para 0038 and 0040 and 0048)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Lawrence to include comparing an amount of a transaction to the mandatory SAR threshold in accordance with comparison taught by LawrenceI in order to generate suspicious activity report.

As per claim 2, Lawrence discloses further comprising transmitting the suspicious activity report to authorities (see column 4 para 0044).

As per claim 3, Lawrence discloses wherein transmitting the suspicious activity report to authorities comprises:

collecting suspicious activity reports at a host computer system; and transmitting the collected suspicious activity reports to a computer system of the authorities (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 lines 0031and column 4 para 0044).

As per claim 4, Lawrence discloses further comprising receiving additional information and including the additional information in the suspicious activity report (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 lines 0031and column 4 para 0044).

As per claim 5, Lawrence discloses a method of producing a suspicious activity report comprising:

storing configuration information at a transaction processing device wherein the configuration information configures the device to produce suspicious activity reports based on certain criteria ("i.e. risk criteria" see column 6 para 0067-0072) receiving transaction

information, determining based on the transaction information and the certain criteria whether a suspicious activity report is to be prepared(see column 2-3 para 0027 and column 3-4 para 0040 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078) and generating a suspicious activity report containing at least some of the transaction information(see column 8 para 0089 and column 9 para 0091 column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044) wherein generating a suspicious activity report comprises, printing a suspicious activity report having a portion of the additional information and also having blanks for receiving additional suspicious activity report information (see column 8 para 0089 and column 9 para 0091).

As per claim 11, Lawrence discloses wherein determining whether a suspicious activity report is to be prepared comprises determining whether an operator has elected to produce an on-demand SAR (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 12, Lawrence discloses further comprising printing a report relating to suspicious activity reports produced at the transaction processing device during a period of 3 time (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 13, Lawrence discloses wherein the transaction processing device is configured to print money orders (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 14, Lawrence discloses a transaction processing device, comprising:
an input device arranged to receive transaction information and SAR 3 information, a display screen arranged to display information to an operator and application software that programs the transaction device to:
store configuration information, wherein the configuration information configures the device to produce suspicious activity reports based on certain criteria, receive transaction information (see

column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044) determine based on the transaction information and the certain criteria, whether a suspicious activity report is to be prepared (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044).

As per claim 14, Lawrence discloses a transaction processing device, comprising: an input device arranged to receive transaction information and SAR information(see column 2-3 para 0027 and para 0076) a display screen(see column para 0066 and para 0019) arranged to display information to an operator(see column 8 para 0090 and application software that programs the transaction device to:

store configuration information(see column 2-3 para 0027), wherein the configuration information

configures the device to produce suspicious activity reports based on certain criteria (see column 6 para 0067 and column 8 para 0089 and column 9 para 0091) wherein the certain criteria comprises both a SAR prompt threshold and a mandatory SAR threshold(see column 5 para 0053) receive transaction information (see column 7 para 0076) whether a suspicious activity report is to be prepared and generate a suspicious activity report containing at least some of the transaction information see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044).

Lawrence fails to explicitly teach determine based on the transaction information and the certain criteria.

However Lawrence1 discloses information entered by a subscriber into a PRM system may be information gathered according to normal course of dealings with a particular network address or as a result of a concerted investigation. In addition, since the PRM system is proprietary and a subscriber responsible for the information contained therein can control access to the information contained therein, the PRM system can include information that is public or proprietary. If desired, information entered into the PRM system can be shared with a RMC system. Informational data can be shared, for example via an electronic transmission or transfer

of electronic media. However, RMC system data may be subject to applicable local or national law and safeguards should be adhered to in order to avoid violation of such law through data sharing practices. In the event that a subscriber, or other interested party, discovers or suspects that a person or entity is involved in a fraudulent or otherwise illegal activity the system can report related information to an appropriate authority.(see column 1 para 0005 and column 4 para 0042 and column 5 para 0057 and column 10 para 0113).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Lawrence to include determine based on the transaction information and the certain criteria taught by Lawrence1 in order to generate suspicious activity report.

As per claim 16, Lawrence discloses wherein the application software also programs the transaction device to compare an amount of a transaction to the mandatory SAR threshold (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044).

As per claim 18, Lawrence discloses wherein the application software also programs the transaction device to compare an amount of a transaction to the SAR prompt threshold (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044).

As per claim 19, Lawrence discloses wherein the application software further programs the transaction device to:
display a prompt that asks an operator if he wants to prepare a suspicious activity report; and
receive a response to the prompt (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044).

As per claim 20, Lawrence discloses wherein the application software also programs the transaction device to determine whether an operator has elected to produce an on-demand SAR (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para

0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044).

As per claim 21, Lawrence discloses wherein the application software further programs the transaction device to print a report relating to SARs produced at the transaction processing device during a period of time (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044).

As per claim 22, Lawrence discloses wherein the transaction processing device is configured to print money orders (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044).

Conclusion

RESPONSE TO arguments

4. Applicant's arguments filed 10/22/08 has been fully considered but they are not persuasive for the following reasons.

5. In response to Applicant's arguments that Lawrence and Lawrence1 fail to teach or suggest" storing configuration information at a transaction processing device, wherein the configuration information configures the device to produce suspicious activity reports based on certain criteria, and wherein the certain criteria comprises both a mandatory SAR threshold and a SAR prompt threshold and mandatory SAR threshold and a SAR prompt threshold" the examiner disagrees with Applicant's because these limitations were addressed as stated.

Lawrence teaches storing configuration information at a transaction processing device, wherein the configuration information configures the device to produce suspicious activity reports based on certain criteria("i.e. risk criteria" see column 6 para 0067-0072) receiving transaction information(see column 2-3 para 0027 and column 3-4 para 0040 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078) determining, based on the transaction information and the certain criteria, whether a suspicious activity report is to be prepared.(see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044).

Lawrence1 teaches information entered by a subscriber into a PRM system may be information gathered according to normal course of dealings with a particular network address or as a result of a concerted investigation. In addition, since the PRM system is proprietary and a subscriber responsible for the information contained therein can control access to the information contained therein, the PRM system can include information that is public or proprietary. If desired, information entered into the PRM system can be shared with a RMC system 106. Informational data can be shared, for example via an electronic transmission or transfer of electronic media. However, RMC system data may be subject to applicable local or national law and safeguards should be adhered to in order to avoid violation of such law through data sharing practices. In the event that a subscriber, or other interested party, discovers or suspects that a person or entity is involved in a fraudulent or otherwise illegal activity the system can report related information to an appropriate authority.(see column 1 para 0005 and column 4 para 0042 and column 5 para 0057 and column 10 para 0113).

Therefore it is obviously clear that Applicant's claimed limitations was taught within the teachings of Lawrence and Lawrence1 would have had to include storing configuration information and some form of criteria in place in which reports are generated and would have been based on some form of trigger or criteria in determining how and when those reports should be generated.

6. Applicant's claims 1, 5, and 14, states " configuration information configures the device to produce suspicious activity reports and an input device arranged to receive transaction information"

However the subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,

Art Unit: 3696

(C) “wherein” clauses, or

(D) “whereby” clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

**>USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”).<

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings.”). Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” Multiform Desiccants Inc. v. Medzam Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B. Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frantzy Poinvil/

Application/Control Number: 10/658,844

Page 11

Art Unit: 3696

Primary Examiner, Art Unit 3696

CG

Jan 19, 2008